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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/130,213	08/06/1998	H. CRAIG DEES	PHO-102	5901

7590

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EXAMINER

BARRETT, THOMAS C

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/130,213

Applicant(s)

DEES ET AL.

Examiner

Thomas C. Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 and 71-110 is/are pending in the application.
- 4a) Of the above claim(s) 78-96 and 108-110 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-54, 75-77 and 97-107 is/are allowed.
- 6) ☒ Claim(s) 55-69 and 71-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

REQUEST FOR CONTINUED EXAMINATION

The request filed on December 21, 2004 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/130,213 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Arguments

Applicant's arguments with respect to claims 55-74 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant argues Latina "appears to teach away from the method and apparatus of the claimed invention by advocating manual repositioning of the treatment beam to a few target spots." Advocating manual repositioning falls far short of the kind of teaching that would discourage one of skill in the art from using a scanning laser. Latina fails to disclose a scanning laser, positively or negatively.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., method of scanning over an extended volume of tissue) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant argues, "the method of Aprile Carpenter is only applicable to treatment of tissue into which an exogenous pigment has been administered". However

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in "Example 1" the method is performed on a tattoo, which is claimed as an "endogenous pigment" in claim 72 of the present application.

The Applicant states, "Instead of describing the claimed method for treatment of tissue using thermal energy (i.e., "thermal overload"), Mourou teaches a method of laser ablation (i.e., "laser induced breakdown") which requires careful avoidance of thermal effects." Mourou is directed towards avoiding thermal effect, i.e. thermal diffusion, only to ***adjacent*** tissue, not to the target tissue. As cited and italicized by the Applicant, Mourou teaches that when using the disclosed method, "There is essentially insufficient time ***for the surrounding area*** to react thermally."

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 55-69 and 72-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Latina (5,549,596) in view of Mourou et al. (5,656,186). Latina discloses a method for treating a volume of tissue containing an endogenous pigment (i.e. melanin), the method comprising the steps of non-invasively treating the volume with a laser light at wavelengths including 590 nm ("approximately" 600 nm) and 1064 nm, to promote the killing of the cells by thermal overload. The tissue can be at the surface, less than approximately 2 mm below the surface, i.e. the trabecular meshwork or greater than approximately 2 mm below the surface, i.e. the retina. However Latina fails to disclose the pulse less than 1 ps. Mourou et al. teaches a method of using a laser comprising pulse durations less than 1 ps (femtosecond) and laser scanning to better localize laser induced breakdown (col. 1, lines 43-47). It would have been obvious to one of ordinary skill in the art to combine the teaching of a method of using a laser comprising pulse durations less than 1 ps, as taught by Mourou et al., to a method for treating a volume of tissue as per Latina, in order to better localize laser induced breakdown.

Claims 55 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aprile Carpenter et al. (EP 0 649 667 A2) in view of Mourou et al. (5,656,186). Aprile Carpenter et al. discloses a method for treating a volume of tissue containing an endogenous pigment such as tattoo dye, the method comprising the steps of non-invasively treating the volume with an un-focused laser light (col. 5, lines 15-19) to promote the killing of the cells by thermal overload (Example 1). However Aprile Carpenter et al. fails to disclose the use of a scanning laser. Mourou et al. teaches a

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method of using laser scanning to better localize laser-induced breakdown (col. 1, lines 43-47). It would have been obvious to one of ordinary skill in the art to combine the teaching of a method of using a laser comprising pulse durations less than 1 ps, as taught by Mourou et al., to a method for treating a volume of tissue as per Aprile Carpenter et al., in order to better localize laser induced breakdown.

Allowable Subject Matter

Claims 1-54, 75-77, and 97-107 are allowable over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (703) 308-8295. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703) 308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Tom Barrett", with a stylized flourish at the end.

Thomas Barrett